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AF/1626
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Michael SCHMIDT et al. : Group Art Unit: 1626
Serial No.: 09/877,259 : Examiner: A. Small
Filed: June 11, 2001 :
For: IONIC LIQUIDS II

JUN 18 2004

TECH CENTER 10001203

**PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181, REQUESTING
WITHDRAWAL OF REQUIREMENT FOR RESTRICTION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

This is a petition courteously submitted under 37 CFR § 1.181, requesting the Commissioner, through the Honorable Group Director, to instruct the Examiner to withdraw the Restriction requirement of April 21, 2003.

Statement of Facts

On February 10, 2003, the Examiner issued an Office Action setting forth a Restriction Requirement. In the Restriction, the claims were grouped as follows: Group I, claims 1-7; Group II, claims 8, 10 and 11; and Group III, claim 9. Group I was said to be drawn to an ionic liquid. Group II, was said to be drawn to an electrochemical cell, and an electrolyte composition. Group III was said to be drawn to a capacitor. The groups of claims were said to be related as "mutually exclusive species in an intermediate-final product relationship." In addition to the Restriction Requirement, the Examiner also made an Election of Species Requirement.

On March 6, 2003, Applicants filed an Election and Amendment. In this paper, Applicants elected Group I as the elected invention and selected the compound 1-ethyl-3-methylimidazolium tris(pentafluoroethyl)-trifluorophosphate as the elected species. The Restriction Requirement was traversed on grounds that the inventions were not related as intermediate-final product but instead were related as subcombination - combination. Thereafter,

the Examiner issued a further Office Action on April 21, 2003. In this Office Action, the Examiner again restated the Restriction. However, the Examiner agreed with Applicants' prior arguments that the groups were not related as intermediate-final product. Instead, the Examiner gave a new reasoning in support of the Restriction. Specifically, the Examiner stated the following:

"Inventions of group I and groups II and III are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in materially different process of using that product (MPEP §806.05(h)). In the instant case, the product of group I may be used in two materially different ways, one in an electrochemical cell and the other in a capacitor."

In the Reply filed July 21, 2003, Applicants again traversed the Restriction Requirement. Applicants argued that the claims of Group I and the claims of Groups II and III are not related as product and process of use since none of claims 8-11 were process claims. In the Office Action of December 17, 2003, the Examiner responded to Applicants argument as follows:

"The examiner respectfully disagrees. The indication that claims 8-11 are process claims was not made. The reference to process with regard to claims 8-11 was made with regard to the relationship between Group I to Groups II and III. Groups II and III are drawn to electrochemical cells and capacitors respectively that employ the ionic liquid of Group I in them, hence they are in fact is [sic] a process for using the compounds of group I."

Points to be Reviewed

In particular, the issue for review is whether Restriction is justified on the basis that the groups of claims are related as product and process of use, pursuant to MPEP § 806.05(b), when none of the claims are process claims.

Arguments in Support of Petition

It is self-evident that the claims of the Group II and III are not process claims. Despite this fact, the Examiner appears to argue that the claims of Group I and the device and composition claims of Groups II and III can be "related" as product and process of use. The Examiner argues the Restriction in this case is justified under MPEP §806.05(h). However, nothing within this section of the MPEP indicates that such a Restriction is appropriate in situations where there are no process claims. This section of the MPEP clearly makes reference to the "process of using as claimed," not an alleged imply process resulting from using the device or composition as claimed. Nor does this section of the MPEP suggest the meaning of "related" which is relied on for the basis of the Restriction.

Contrary to the assertion in the Restriction, the claims of Group I and the claims of Groups II and III are not related as products and process of use, but instead are related as subcombination and combination. See MPEP 806.05(c). This type of relationship requires a two-way distinctness for restriction and such two-way distinctiveness has not been shown. Further, there is no serious burden imposed upon the PTO in examining the claims of Group II and III with the elected claims of Group I. See MPEP §803. Once the product claims of Group I are found to be allowable, the combination claims of Groups II and III will also necessarily be allowable.

Relief Requested

For the forgoing reasons, Applicants request that the Examiner be directed to withdraw the Restriction Requirement set forth in the Office Action of April 21, 2003 and examine the claims of Groups II and Groups III with the elected claims of Group I.

Respectfully submitted,



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